

REMARKS

The Amendments

Claim 13 is amended to incorporate the substance of previous claim 14 with the addition aspect that the phenylene ring is excluded from the definition of rings A²¹ or A²².

It is submitted that the above amendments would put the application in condition for allowance or materially reduce or simplify the issues for appeal. The amendments do not raise new issues or present new matter since they incorporate subject matter from a dependent claim, already examined, into the independent claim. The amendment presents 6 additional claims but also cancels 4 finally rejected claims. The newly added claims are merely dependent claims ultimately from the above-discussed independent claim and are not believed to raise additional issues. The new claims find support in the specification, for example, at page 4, lines 8-12, and compounds IIc - Iie at pages 7-8. The amendments have been made to address to new rejections over new prior art made in the Final Office Action and, thus, were not earlier presented. Accordingly, it is submitted that the requested amendments should be entered.

To the extent that the amendments avoid the prior art or for other reasons related to patentability, competitors are warned that the amendments are not intended to and do not limit the scope of equivalents which may be asserted on subject matter outside the literal scope of any patented claims but not anticipated or rendered obvious by the prior art or otherwise unpatentable to applicants. Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

The First Rejection under 35 U.S.C. § 102

The rejection of claims 13 and 16 under 35 U.S.C. § 102, as being anticipated by Kondo (U.S. Patent No. 5,733,477 or 5,820,784), is respectfully traversed.

6/K Initially, it is noted that this rejection was not applied against claim 14 and that claim 13, upon which claims 15-17, 19 and 22-28 ultimately depend, now incorporates a narrower version of the subject matter of previous claim 14. Since the subject matter of claim 14 was not rejected on this basis, narrower subject matter within previous claim 14 clearly would also not be rejected. Thus, it is believed the amendment overcomes this rejection. However, the following comments are provided for completeness.

The Kondo '477 and '784 patents fail to describe, as required for anticipation purposes, a liquid-crystalline medium containing compounds meeting each of applicants' formulae I and II in instant claim 13. In the '477 patent, the composition examples 2 and 5 contain the compound 5-HHEB(F)-OCF₃ but no additional compound in those compositions which is a two ring compound, let alone a two ring compound of applicants' formula II. In the '784 patent, compositions with HHEB(F)-OCF₃ compounds are disclosed but there are no additional two rings compounds in these compositions meeting applicants' formula II. The additional two ring compounds are distinct because they have an HB structure, have a first B ring without lateral substitution (compare the amended A²¹ and A²² ring definition for formula II in claim 13) and/or have an -OCF₃ terminal group. Thus, no actually described composition of these patents meets all elements of the instant claims and they cannot anticipate.

Although no obviousness rejection was made over this reference, it is additionally pointed out that the Kondo references do not suggest modification of their compositions in a manner rendering obvious the claimed invention. The '477 and '784 patents do not even

generically suggest a two ring compound meeting applicants' formula II in their compositions. The only two ring compounds generically suggested for use in the reference compositions either have a cyclohexylene-phenylene ring combination or an unsubstituted phenylene-phenylene ring combination neither of which meet applicants' formula II. That the references provide a broad generic teaching yet still do not even generically encompass the instant compositions strongly suggests absence of obviousness.

The Second Rejection under 35 U.S.C. § 102

The rejection of claims 13-20 under 35 U.S.C. § 102, as being anticipated by Kondo (U.S. Patent No. 6,051,288 or WO 96/32365), is respectfully traversed.

The US and WO patents derive from the same priority document and, thus, are assumed to have similar disclosures. The discussion here will refer to the US patent.

Composition Example 18 of Kondo '288 does not meet all the elements of the instant claims. The composition does not contain a compound which is a two ring compound wherein each of the two rings is a laterally fluorinated phenylene ring, a dioxanyl ring or a pyrimidinyl ring. Compare amended claim 13, particularly the definition of the A²¹ and A²² rings. The other actually described compositions of Kondo '288 also fail to include compounds meeting each of applicants' formula I and II. Accordingly, Kondo '288 does not provide a description of an embodiment of the invention to support anticipation. The 35 U.S.C. § 102 rejection should be withdrawn.

Kondo '288 also does not support an obviousness rejection under 35 U.S.C. § 103. Kondo '288 provides a very broad generic description. Although it is so broad that it apparently encompasses the use of compounds meeting each of applicants' formula I and II, there is no direction at all to pick specific compounds meeting each of these formulae and,

particularly not, any suggestion to pick such specific compounds and combine them in a single composition. Kondo '288 discloses many specific composition examples each of which contain numerous components. Yet no composition contains both a component meeting applicants' formula I and a component meeting applicants' formula II. It appears that some of the compositions contain compounds meeting formula I. Only a few, i.e., Examples 20, 21, 38 and 42, appear to contain compounds meeting applicants' formula II but none of these examples are the ones which contain a compound of applicants' formula I. Thus, rather than suggesting picking compounds out of the broad generic disclosure to meet applicants' formula I and formula II and combining these in a single composition, the examples direct away from such a selection. Nothing in the Kondo disclosure suggest applicants' combination. Thus, Kondo '288 also would not render the claimed invention obvious under 35 U.S.C. § 103.

The Objection to Claims 21 and 22

The objection to claims 21 and 22 is rendered moot by the cancellation thereof.

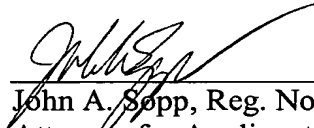
Allowable Subject Matter

The indication of allowability of the subject matter of claims 1-12 is respectfully acknowledged. These claims remain the same.

It is submitted that the application is in condition for allowance. But the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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Attorney Docket No.: MERCK-2224

Date: August 12, 2003

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